

IN THE DRAWINGS

Applicants submit herewith formal drawings to replace the filed informal drawings.

REMARKS

Claims 1-25 were pending in the Application.

Claims 26-49 are added and hence claims 1-49 are pending in the Application. There is support for newly added claims 26-49 at page 6, line 12 – page 13, line 20 of the Specification. No new matter has been introduced.

Claims 1-25 stand rejected.

Applicants thank the Examiner for discussing the Office Action with Applicants' attorney on May 25, 2006.

Applicants assert that claims 1 and 5 were not amended to overcome prior art but to clarify the claimed subject matter and to provide sufficient antecedent basis. Hence, no prosecution history estoppel arises from the amendments to claims 1 and 5. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1 and 5 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. DRAWING OBJECTIONS

The Office Action objects to Figure 2A for allegedly using reference number 212 to designate both a program administrator and part of the database. Upon review of Figure 2A, reference number 212 only designates the program administrator.

The Office Action further objects to the drawings for allegedly not including the reference number 214 as mentioned in the description. Applicants respectfully direct the Examiner's attention to Figure 2A which uses the reference number 214 as part of the database (reference number 210).

The Office Action further objects to the drawings for including the reference number 510 that allegedly is not mentioned in the description. Applicants respectfully direct the Examiner's attention to page 10, lines 26-28 of the Specification which mentions reference number 510.

The Office Action further objects to the drawings for using reference numbers that designate both recipients and geographical entities or both recipients and links. Applicants have amended the Specification (page 11, lines 25-29) to clarify the designation of reference numbers 703, 705, 707, 709, 711, 713, 715 and 717.

Applicants submit herewith formal drawings of Figures 1-8 which address the Office Action's other drawing objections.

As a result of the foregoing, Applicants respectfully request the Office Action to withdraw the objections to the drawings.

II. REJECTIONS UNDER 35 U.S.C. §112

The Office Action has rejected claims 5 and 8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Office Action asserts that the limitation of "wherein said substep of comparing a set of profile attributes values" in claim 5 lacks antecedent basis. Applicants have amended claims 1 and 5 to state a "set of package profile attributes" thereby clarifying the claimed subject matter as well as providing sufficient antecedent basis for the limitation identified by the Office Action.

Further, the Office Action asserts that the limitation of "if said attribute is single-valued" in claim 5 refers to the profile attribute or to the current attribute. Applicants have amended claim 5 to specify the current attribute.

As a result, Applicants respectfully request the Office Action to withdraw the rejections of claims 5 and 8 under 35 U.S.C. §112, second paragraph.

III. REJECTIONS UNDER 35 U.S.C. §102

The Office Action has rejected claims 1-4, 6, 9-13, 15, 18-22 and 25 under 35 U.S.C. §102(e) as being anticipated by *Svancarek et al.* (U.S. Publication No. 2004/0039705). Applicants respectfully traverse.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Regarding claims 1, 10 and 19, Applicants respectfully assert that *Svancarek* does not disclose "wherein said step of determining if said recipient is entitled to said service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient." The Office Action relies upon paragraph [0034] of *Svancarek* as disclosing the above-cited claim limitation. Applicants respectfully traverse and assert that *Svancarek* instead discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Further, *Svancarek* discloses that the eligibility service may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. There is no language in the cited passage that discloses comparing a set of administrator-configurable package profile attributes values with corresponding values for the recipient. Neither is there any language in the cited passage that discloses comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with corresponding values for the recipient. Thus, *Svancarek* does not disclose all of the limitations of claims 1, 10 and 19.

Regarding claims 3, 12 and 21, Applicants respectfully assert that *Svancarek* does not disclose "configuring said set of package attributes wherein said set of

package attributes includes selected attributes having one or more attribute values." The Office Action relies upon paragraphs [0034], [0036] and [0037] of *Svancarek* as disclosing the above-cited claim limitation. Applicants respectfully traverse and assert that *Svancarek* instead discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Further, *Svancarek* discloses that the eligibility service may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. In addition, *Svancarek* discloses that if the eligibility service determines that the customer is eligible to receive a product key for activating the software product at issue, then the eligibility service notifies the portal of same and also determines and identifies to the portal the proper type of product key to be distributed to the customer. [0036]. Additionally, *Svancarek* discloses that the portal redirects the customer to an appropriate location to obtain/purchase the required product key. [0037]. There is no language in the cited passages that discloses configuring a set of package attributes. Neither is there any language in the cited passages that discloses configuring a set of package attributes where the set of package attributes includes selected attributes having one or more attribute values. Thus, *Svancarek* does not disclose all of the limitations of claims 3, 12 and 21.

Regarding claims 4, 13 and 22, Applicants further assert that *Svancarek* does not disclose "determining if said service includes a limited number of accesses." The Office Action relies upon paragraphs [0035] and [0042] of *Svancarek* as disclosing the above-cited claim limitation. Applicants respectfully traverse and assert that *Svancarek* instead discloses that in the case where the portal was reached because a product activation attempt failed due to an already-used product key, the eligibility service may also determine by reference to a product key distribution database whether the already-used product key has previously resulted in the distribution of a set number of additional product keys. [0035]. Further, *Svancarek* discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, *Svancarek*

discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. There is no language in the cited passages that discloses determining if the service includes a limited number of accesses. Thus, *Svancarek* does not disclose all of the limitations of claims 4, 13 and 22.

Regarding claims 4, 13 and 22, Applicants further assert that *Svancarek* does not disclose "if said service includes a limited number of accesses, decrementing a tracking count associated with the service." The Office Action relies upon paragraphs [0042] and [0043] of *Svancarek* as disclosing the above-cited claim limitation. Applicants respectfully traverse and assert that *Svancarek* instead discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, *Svancarek* discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. Further, *Svancarek* discloses that the customer employs the delivered product key to activate the software product on a particular computing device by way of the product activation service and the activation database is updated to reflect that the product key has in fact been employed to activate the corresponding software product on the particular computing device as represented by the ID thereof. [0043]. There is no language in the cited passages that discloses that if the service includes a limited number of accesses, then a tracking count associated with the service is decremented. Thus, *Svancarek* does not disclose all of the limitations of claims 4, 13 and 22.

Regarding claims 9, 18 and 25, Applicants further assert that *Svancarek* does not disclose "logging a delivery of said service." The Office Action relies upon paragraphs [0040]-[0042] of *Svancarek* as disclosing the above-cited claim limitation.

Applicants respectfully traverse and assert that *Svancarek* instead discloses that once the transaction is complete, the distributor reports the distribution of the product key to a reporting service. [0040]. *Svancarek* further discloses that the reporting service stores in the database a link between any information which was logged at the portal, allows the portal to discover such link when determining eligibility at a later time in connection with the copy of the software product, allows the provider to track the history of the copy of the software product and the distributed product keys therefor, and also can enforce any predefined business rules. [0041]. Additionally, *Svancarek* discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, *Svancarek* discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. However, there is no language in the cited passages that discloses logging a delivery of a service. Thus, *Svancarek* does not disclose all of the limitations of claims 9, 18 and 25.

Regarding claims 9, 18 and 25, Applicants further assert that *Svancarek* does not disclose "decrementing a number of available instances of said service if said service has a limited usage count." The Office Action relies upon [0042] of *Svancarek* as disclosing the above-cited claim limitation. Applicants respectfully traverse and assert that *Svancarek* instead discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, *Svancarek* discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. There is no language in the cited passage that discloses decrementing a number of available instances of the service. Neither is

there any language in the cited passage that discloses decrementing a number of available instances of the service if the service has a limited usage count. Thus, *Svancarek* does not disclose all of the limitations of claims 9, 18 and 25.

Regarding claims 9, 18 and 25, Applicants further assert that *Svancarek* does not disclose "sending a message to said recipient indicating said recipient is not entitled to said service if the limited usage count has been consumed." The Office Action relies upon [0035] of *Svancarek* as disclosing the above-cited claim limitation. Applicants respectfully traverse and assert that *Svancarek* instead discloses that in the case where the portal was reached because a product activation attempt failed due to an already-used product key, the eligibility service may also determine by reference to a product key distribution database whether the already-used product key has previously resulted in the distribution of a set number of additional product keys. [0035]. There is no language in the cited passage that discloses sending a message to the recipient indicating the recipient is not entitled to the service if the limited usage count has been consumed. Thus, *Svancarek* does not disclose all of the limitations of claims 9, 18 and 25.

Further, regarding claims 26-49, Applicants respectfully assert that *Svancarek* does not disclose the limitations of claims 26-49.

As a result of the foregoing, Applicants respectfully assert that each and every claim limitation is not found within *Svancarek*, and thus claims 1-4, 6, 9-13, 15, 18-22 and 25-49 are not anticipated by *Svancarek*.

IV. REJECTIONS UNDER 35 U.S.C. §103(a)

A. Claims 5, 8, 14, 17, 23 and 24 are patentable over *Svancarek et al.* in view of *Talbot et al.*

The Office Action has rejected claims 5, 8, 14, 17, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over *Svancarek et al.* in view of *Talbot et al.* (U.S. Publication No. 2002/0116312). Applicants respectfully traverse.

1. *Svancarek* and *Talbot* do not teach or suggest the following claim limitations.

Regarding claims 5, 14 and 23, Applicants respectfully assert that *Svancarek* and *Talbot* taken singly or in combination, do not teach or suggest "wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in said set of profile attributes, determining if a current attribute is single-valued; and if said current attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said recipient miscompare." The Office Action relies upon paragraphs [0043]-[0044] of *Talbot* for teaching determining if a current attribute is single-valued. The Office Action further relies upon paragraph [0034] of *Svancarek* for teaching the remainder of the above-cited claim limitations. Applicants respectfully traverse.

Svancarek instead discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034]. Further, *Svancarek* discloses that the eligibility service may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. There is no language in the cited passage that discloses a set of profile attributes. Neither is there any language in the cited passage that discloses determining the recipient is not entitled if a value of the current attribute and a corresponding value for the recipient miscompare. Neither is there any language in the cited passage that discloses determining the recipient is not entitled if a value of the current attribute and a corresponding value for the recipient miscompare if the current attribute is single-valued. Therefore, the Office Action has not presented a *prima facie* case of obviousness in rejecting claims 5, 14 and 23, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, *Talbot* instead discloses that if it is determined that any of the single value exclusions apply, the credit request is filtered out. [0043]. *Talbot* further discloses that if none of the single value exclusions apply, the credit request will be filtered by a second-pass filter involving multiple value factors. *Talbot* further discloses that if it is determined that any of the multiple value exclusions apply, the credit request is filtered out and will not be shown to that lender. [0044]. There is no language in the cited passages that discloses determining if a current attribute is single-valued. Neither is there any language in the cited passages that discloses determining if a current attribute is single-valued for each profile attribute. Therefore, the Office Action has not presented a *prima facie* case of obviousness in rejecting claims 5, 14 and 23, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Regarding claims 8, 17 and 24, Applicants respectfully assert that *Svancarek* and *Talbot* taken singly or in combination, do not teach or suggest "wherein if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare." As understood by Applicants, the Office Action relies upon paragraph [0034] of *Svancarek* as disclosing the above-cited claim limitation. The Examiner previously cited paragraphs [0043]-[0044] of *Talbot* as teaching determining if the attribute value is single-valued or not. However, this limitation is not recited in claims 8, 17 and 24. As a result, Applicants assume that the Office Action relies upon paragraph [0034] of *Svancarek* as disclosing the entire above-cited claim limitation. If Applicants are incorrect, Applicants respectfully request the Office Action to clarify the rejection pursuant to 37 C.F.R. §1.104(c)(2). Nevertheless, Applicants respectfully traverse the assertion that *Svancarek* teaches the above-cited claim limitation.

Svancarek instead discloses that upon collecting all appropriate information, the portal then sends such information to an eligibility service that determines whether the user is qualified to obtain/purchase the desired product key. [0034].

There is no language in the cited passage that teaches determining the recipient is not entitled if each value of the current attribute and a corresponding value for the recipient miscompare. Neither is there any language in the cited passage that teaches where if the current attribute is not single-valued, determining the recipient is not entitled if each value of the current attribute and a corresponding value for the recipient miscompare. Therefore, the Office Action has not presented a *prima facie* case of obviousness in rejecting claims 8, 17 and 24, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Motivation to combine is insufficient to establish a *prima facie* case of obviousness in rejecting claims 5, 14 and 23.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *Id.* Therefore, an Office Action may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Office Action must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *Id.* at 1458. Whether the Office Action relies on an express or an implicit showing, the Office Action must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). A motivation to combine references cannot be supported by merely by the Examiner's subjective opinion.

The Office Action admits that *Svancarek* does not teach determining if a current attribute is single-valued, as recited in claim 5 and similarly in claims 14 and 23. The asserted motivation for modifying *Svancarek* with *Talbot* to include the above-cited claim limitation is to "allow for a service provider to offer their services to those more likely to desire them or to those providers desire more by using

provider-driven filtering criteria." Office Action (3/29/2006), page 8. The source of the Office Action's motivation is paragraph [0012] of *Talbot*. This motivation is insufficient to support a *prima facie* case of obviousness.

The Office Action has not provided any reasons as to why one skilled in the art would modify *Svancarek*, which teaches allowing the customer to obtain/purchase a product key in an automated manner from the developer of the software product or an agent thereof or the like, to determine if a current attribute is single-value (missing claim limitation of *Svancarek*). The Office Action has not explained how allowing for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria (motivation) relates to determining if a current attribute is single-value (missing claim limitation). Neither does the Office Action explain how allowing for a service provider to offer their services to those more likely to desire them or to those providers desire more by using provider-driven filtering criteria (motivation) relates to the problem addressed by *Svancarek* (allowing the customer to obtain/purchase a product key in an automated manner from the developer of the software product or an agent thereof or the like). As a result, the Office Action has not provided reasons as to why the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify *Svancarek* to include the missing claim limitations of claims 5, 14 and 23. Therefore, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 5, 14 and 23. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

B. Claims 7 and 16 are patentable over *Svancarek et al.*

The Office Action has rejected claims 7 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Svancarek*. Applicants respectfully traverse.

1. Improper use of *In re Gulack* and *In re Lowrey*.

The Office Action states:

As analyzed above, Svancarek et al. shows presenting the recipient with alternate content when the recipient is not entitled to the requested service. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the presenting step recited. The data to be displayed when the recipient is found ineligible does not change the function being performed. The presenting of alternate content would be performed in the same manner regardless of the exact composition of the content, whether a message, an alternate website or a description of criteria. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Svancarek et al. in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Office Action (3/29/2006), page 8.

Applicants respectfully traverse the Office Action's use of *In re Gulack* and *In re Lowrey* to support the Office Action's contention that the limitation of claims 7 and 16 can be ignored simply because the Office Action deems the limitations to be non-functional.

In re Gulack and *In re Lowrey* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106. That is not the case here. As Applicants pointed out, there are numerous limitations in the claimed inventions not taught or suggested in the cited prior art. Consequently, the Office Action's reliance of *In re Gulack* and *In re Lowrey* is improper.

Further, in order to establish a *prima facie* case of obviousness, the Office Action must provide a reference or combination of references that teaches or suggests all of the claim limitations. M.P.E.P. §2143. The Office Action cannot ignore claim language. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Since the Office Action has not cited to any passage in Svancarek as teaching the above-cited claim limitation, the Office Action

has not established a *prima facie* case of obviousness in rejecting claims 7 and 16. M.P.E.P. §2143.

2. Office Action's motivation for modifying *Svancarek* is inadequate.

The Office Action states:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to present alternate content obtain when the recipient is ineligible for the service regardless of the specific composition of the content, whether a message, an alternate website or a description of criteria, because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention. Office Action (3/29/2006), page 9.

As stated above, in order to establish a *prima facie* case of obviousness, the Office Action must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Office Action must provide some suggestion or motivation to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or an implicit showing, the Office Action must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Office Action's statement that "because such content does not functionally relate to presenting step and also because the content to be displayed does not patentably distinguish the claimed invention" does not provide objective reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify *Svancarek* to include the missing claim limitations of claims 7 and 16. Accordingly, the Office Action has not presented a *prima facie* case of obviousness for rejecting claims 7 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

- C. Claims 26-49 are patentable over *Svancarek et al.* in view of *Talbot et al.*

Regarding claims 26-49, Applicants respectfully assert that *Svancarek* and *Talbot*, taken singly or in combination, do not teach or suggest the limitations of claims 26-49.

V. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-49 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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